



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,379	10/20/2003	Craig D. Yardley	12039 D1D1	3363
31743	7590	07/21/2009	EXAMINER	
Georgia-Pacific LLC 133 Peachtree Street NE - GA030-41 ATLANTA, GA 30303				HARMON, CHRISTOPHER R
ART UNIT		PAPER NUMBER		
3721				
MAIL DATE		DELIVERY MODE		
07/21/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG D. YARDLEY, CHESTER W. GOODING, Jr.,
and BYRON E. BURRIER

Appeal 2009-001146
Application 10/689,379
Technology Center 3700

Decided¹: July 21, 2009

Before LINDA E. HORNER, JOHN C. KERINS, and MICHAEL W.
O'NEILL, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Craig D. Yardley et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 80-90, the only claims pending in the case. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

An oral hearing was conducted on June 25, 2009, with Robert C. Stanley, Esq., appearing on behalf of Appellants.

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

Appellants' claimed invention is to a method of making a paper napkin including the steps of providing a single-ply paper web having a machine direction and a cross-machine direction, with a longitudinal dimension being in the machine direction, the longitudinal dimension being at least about two times a transverse dimension, and folding one transverse free edge of the web toward the other transverse free edge to create two panels, resulting in a napkin that has no longitudinal fold and at least one transverse fold. (Appeal Br., Claims Appendix, Claim 80). Claim 80, reproduced below, is representative of the claimed subject matter:

80. A method of making a paper napkin comprising:

(a) providing a single-ply paper web having a machine direction and a cross machine direction, wherein a longitudinal dimension is in the machine direction and a transverse dimension is in the cross-machine direction, and wherein the

longitudinal dimension is at least about two times the transverse dimension;

(b) optionally orienting the web for longitudinal folding in the machine direction; and

(c) folding one transverse free edge of the single-ply paper web toward the other transverse free edge to create two panels in the single-ply paper web;

wherein the napkin contains no longitudinal fold and at least one transverse fold.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Lazar	US 1,256,334	Feb. 12, 1918
Ito	US 4,469,243	Sep. 4, 1984
Chan	US 5,716,691	Feb. 10, 1998

The Examiner has rejected:

(i) claims 80-90 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention;

(ii) claims 80, 81, 84, 86 and 90 under 35 U.S.C. § 102(b) as being anticipated by Lazar;

(iii) claims 84, 85 and 88 under 35 U.S.C. § 102(b) as being anticipated by Chan;

(iv) claims 82, 83, and 87 under 35 U.S.C. § 103(a) as being unpatentable over Lazar in view of “Applicant’s Admitted Prior Art” (AAPA); and

(v) claims 84, 85, 88 and 89 under 35 U.S.C. § 103(a) as being unpatentable over Ito.

ISSUES

The Examiner concluded that the presence of the term “about” in reciting a ratio of longitudinal dimension to transverse dimension renders the claims indefinite. Appellants contend that the term does not automatically give rise to an indefiniteness problem, and that the dimensions of the paper webs may readily and accurately be measured to produce the data from which to calculate the ratio. The issue joined is whether Appellants have shown that the Examiner erred in failing to establish that a person of ordinary skill in the art would not be able to understand the scope of the claims, due to the presence of the term “about”.

The Examiner found that the Lazar patent and the Chan patent identically disclose a method for making a paper napkin by folding a single ply paper web, and that the claims cannot be distinguished from the prior art on the basis that the longitudinal and transverse dimensions of the paper web are in the machine direction and cross-machine direction, respectively.

Appellants contend that Lazar and Chan implicitly disclose a folding process in which the longitudinal dimension of the web is in the cross-machine direction, and the transverse dimension is in the machine direction, and that their claim limitations do distinguish over these patents. The issue joined in this aspect of the appeal is whether Appellants have shown that the

Examiner erred in failing to establish that Lazar and Chan disclose the claimed relationships between longitudinal and transverse dimensions, and the machine and cross-machine directions.

The Examiner concluded that it would have been obvious, in view of Lazar and alleged “admitted prior art”, to perform the Lazar method employing webs having the materials properties and sizes and weights of webs set forth in dependent claims 82, 83, and 87. Appellants contend that Lazar and any so-called “admitted prior art” fail to disclose or suggest the claimed relationships between longitudinal and transverse dimensions, and the machine and cross-machine directions. The issue joined in this aspect of the appeal is whether Appellants have shown that the Examiner erred in failing to establish that Lazar and the “admitted prior art” disclose or suggest the claimed relationships between longitudinal and transverse dimensions, and the machine and cross-machine directions.

The Examiner further concluded, with respect to claims 84, 85, 88 and 89, that it would have been obvious to a person of ordinary skill in the art to practice the method disclosed in the Ito patent with a single-ply paper web, to produce wipes. Appellants contend that such a modification would yield a product that is unsuitable for its intended use, and further that the Examiner has failed to establish that the Ito patent discloses or suggests performing its process with a paper web that has a longitudinal dimension that is at least about two times the transverse dimension. The issue here is whether Appellants have shown that the Examiner erred in reaching the conclusion that the claimed invention would have been obvious in view of Ito.

FINDINGS OF FACT

The following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

FF 1. Appellants describe the longitudinal dimension and transverse dimension of the paper webs employed in the preferred embodiments of their invention in conventional and well-understood dimensional units (inches), and these are thus readily susceptible of being accurately measured by any number of methods. (See, e.g., Specification, p. 31, ll. 1-6). Based on these obtained measurements, an accurate determination as to the ratio of longitudinal dimension to transverse dimension can readily be obtained.

FF 2. Appellants describe, in their Specification, the term “square” as being a term connoting that certain materials properties are the same in both the machine direction and in the cross-machine direction, and do not describe it as relating to the dimensions of the web. (Specification, p. 27, ll. 1-5).

FF 3. The Ito patent discloses that a four-ply creped wadding material described in a preferred embodiment could be replaced by a nylon scrim reinforced tissue laminate or a polyolefin material in producing the industrial wipers that are the subject of that patent. (Ito, col. 7, ll. 44-52).

PRINCIPLES OF LAW

The primary purpose of the definiteness requirement set forth in the second paragraph of 35 U.S.C. § 112 is to ensure that the claims are written

in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, *e.g.*, competitors of the patent owner, can determine whether or not they infringe. *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774, 779-80 (Fed. Cir. 2002). The test for definiteness is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

Anticipation under 35 U.S.C. § 102 requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Inherency may not be established by probabilities or possibilities. *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981).

A claim is unpatentable for obviousness under 35 U.S.C. § 103(a) if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and

content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR Int'l.*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”).

ANALYSIS

Claims 80-90—Indefiniteness under 35 U.S.C. § 112, second paragraph

The Examiner concluded that the limitation found in independent claims 80 and 84, as well as in claims 81-83 and 85-90 depending therefrom, directed to the longitudinal dimension of the paper web being “at least about” two times the transverse dimension, is indefinite. (Answer 3). The Examiner’s position is that the scope of “about” is not clear, and that no specific determination can be made as to what Appellants intend to cover by this claim limitation. (*Id.*). The Examiner supports this position with contentions to the effect that claiming the longitudinal dimension in terms of an unspecified transverse dimension yields ambiguity, that there is no specific guidance in the Specification as to how to determine the scope of this term, and that the actual numerical ranges set forth in the Specification for the longitudinal and transverse dimensions are also described as being “about” one value to “about” another value. (Answer 6-7). Finally, the Examiner cites to the decision in *Amgen, Inc. v. Chugai Pharm Co., Ltd.*, 927 F.2d 1200 (Fed. Cir. 1991), noting that the presence of the phrase “at least about” in two patent claims resulted in those claims being adjudged invalid as being indefinite under 35 U.S.C. § 112. (*Id.*).

The *Amgen* decision included an explicit caution that the holding therein that the term “about” rendered indefinite the patent claims at issue, “should not be understood as ruling out any and all uses of this term in patent claims. It may be acceptable in appropriate fact situations … even though it is not here.” *Amgen*, 927 F.2d at 1218. That cautionary language highlights that the determination is to be based on the facts presented in each case. In *Amgen*, the two principal factors that the Court found probative were that the only available method to measure the “specific activity” that was claimed using the term of degree “about” was itself an imprecise form of measurement, and that the term “about” was a significant factor in the patentee’s ability to obtain allowance of the claims at issue over the prior art. *Id.* at 1217-18. Here, the longitudinal dimension and transverse dimension of any given paper web are readily susceptible of being accurately measured by any number of methods, and thus an accurate determination as to the ratio of longitudinal dimension to transverse dimension can readily be obtained. (FF 1). The ratio further, as will be seen in the ensuing discussion of the rejections based on the prior art, is not critical to the patentability of the claims. As such, the outcome in the *Amgen* case is not particularly germane to the present situation.

An earlier decision by the Court of Appeals for the Federal Circuit, in the case of *Seattle Box Co. v. Indust. Crating & Packing, Inc.*, 731 F.2d 818 (Fed. Cir. 1984), is more closely aligned with the facts at hand as well as the claim language at issue. The claims alleged to be indefinite in that case included language requiring that one element be “substantially equal to”

another claim feature.² While noting that, when a claim employs a term of degree, a determination must be made as to whether the patent specification provides some standard for measuring the degree, the Court stated that the ultimate decision to be reached is whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. *Id.* at 826.

In the present claims, the longitudinal dimension is recited as being “at least about two times” the transverse dimension. Not unlike claim 1 under consideration in the *Seattle Box* case (claim language “substantially equal to or greater than”), there does not appear to be an issue as to definiteness with respect to longitudinal dimensions that are two times (or greater) than the transverse dimension. Rather, the issue is only how far the scope of the claim extends, through use of the term “about”, below a 2:1 ratio. The Examiner bears the initial burden of presenting evidence that persons of ordinary skill in the art would not be able to ascertain the scope of this limitation. The Examiner’s contentions, noted above, in support of the indefiniteness rejection, do not rise to the level of establishing that the scope of the claim limitation would not be understood by persons of ordinary skill.

The rejection of claims 80-90 under 35 U.S.C. § 112, second

² Apparatus Claim 1 included the limitation, “each of said series of blocks being located to stand on one of said sleepers and being of a height *substantially equal to or* greater than the thickness of the tier of pipe lengths”, and method Claim 8 included the limitation, “traversing the first tier of pipes with a second plurality of transverse sleepers aligned with said first plurality at each location and vertically [sic] spaced apart by said chocking from said first plurality a distance *substantially equal to or* greater than the diameter of said pipes.” *Seattle Box*, 731 F.2d at 822 (emphasis added).

paragraph, as being indefinite, will not be sustained.

Claims 80, 81, 84, 86 and 90—Anticipation by Lazar

The Examiner has rejected claims 80, 81, 84, 86 and 90 as being anticipated by Lazar. In stating the details of this ground of rejection, the Examiner does not assert that the Lazar patent discloses providing a paper web having a longitudinal dimension in the machine direction of the web and a transverse dimension in the cross-machine direction of the web, which limitations are set forth in independent claims 80 and 84. (Answer 3-4; Appeal Br., Claims Appendix). The Examiner instead contends that Appellants have defined these terms as being inherent properties within the paper web, and specifically have defined these terms as inherent tensile strength properties within the web. (Answer 7). The Examiner further notes that Appellants' Specification discloses an embodiment in which the ratio of tensile strength in the machine direction to the tensile strength in the cross-machine direction approaches 1:1, or a "square"³ web. (*Id.*). The Examiner concludes that, when the paper web is "square" or has a 1:1 ratio of tensile strengths, there is no difference in either direction of the tensile strength of the paper. (*Id.*). As a result, according to the Examiner, "contesting the prior art on the basis that it does not teach paper webs aligned in the claimed direction is inaccurate." (*Id.*).

Appellants assert that, based on the manner in which the paper products of Lazar are folded and subsequently interleaved, persons of

³ In this usage, the term "square" appears to be a term of art connoting that certain material properties are the same in both the machine direction and in the cross-machine direction, and does not relate to the dimensions of the web. (FF 2).

ordinary skill in the art would recognize that the folds made in the paper web of the Lazar arrangement would be longitudinal folds in the machine direction and not transverse folds, whereas the claims require at least one transverse fold and no longitudinal folds. (Reply Br. 11-12). Appellants further assign error to the Examiner's position which treats the machine and cross-machine directions as being defined by tensile strength properties in each direction, and the related implicit finding that because an embodiment is disclosed in which the tensile properties in each direction are equal or approximately equal, the claim limitations setting forth the orientation of the longitudinal and transverse dimensions being aligned with the machine and cross-machine directions of the web, respectively, are not capable of distinguishing the invention over the Lazar patent.⁴ (Reply Br. 5-7).

Appellants' argument describing why persons of ordinary skill in the art would understand that the direction or orientation of the folds in Lazar are opposite to the direction or orientation of the folds as claimed is not sufficiently cogent that we are persuaded that Lazar implicitly discloses such. However, we do agree with Appellants that the Examiner's seeming disregard of the claim limitations directed to the longitudinal dimension of the web being in the machine direction and the transverse dimension being in the cross-machine direction, and the related limitations directed to the direction of the at least one fold, constitutes reversible error.

⁴ Appellants also contend that Lazar discloses a method of folding paper towels, not paper napkins, and that Lazar does not disclose the provision of paper webs having at least about a 2:1 ratio of longitudinal to transverse dimension. (Reply Br. 9-10).

As noted previously, the basic ground of rejection makes no finding as to any disclosure in Lazar that the longitudinal and transverse dimensions are in the machine and cross-machine directions of the web, respectively. The Examiner has effectively ignored these claim limitations by erroneously finding that the terms “machine direction” and “cross-machine direction” are defined by the tensile strength in those directions, and that they are essentially meaningless, when the tensile strengths are equal or approximately equal, in determining patentability over the prior art.

The terms “machine direction” and “cross-machine direction” are, as acknowledged by the Examiner, terms which are understood by those skilled in the art to refer to the directions of a paper web relative to its transport direction through paper making and processing equipment. (Answer 7). The claims here at issue define the provision of a paper web whose longitudinal dimension and machine direction are aligned, and whose transverse dimension is in the direction of the cross-machine direction. The Lazar patent does not explicitly disclose that the longitudinal dimension of its paper web is in the machine direction, nor that the longitudinal dimension is in the cross-machine direction. Appellants argue that Lazar either explicitly or inherently discloses that the longitudinal dimension is in the cross-machine direction, i.e., the opposite of that which is claimed. Appellants’ arguments have not persuaded us that this is necessarily the case in the Lazar disclosure.

The salient fact, however, is that there is not an explicit or inherent disclosure in Lazar that the longitudinal dimension of the web is in the machine direction and that the transverse dimension is in the cross-machine direction. The Examiner as much as acknowledges this by first contending

that the prior art cannot be distinguished on this basis, as well as noting that “[t]he cited prior art references are silent as to which direction the fibers of the paper [which are indicative of machine and cross-machine directions] are aligned.” (Answer 7). The Examiner further states that, “each reference [including Lazar] is silent as to the machine and cross-machine directions of the tensile strength of the paper.” (Answer 8). Thus, while it appears possible that the longitudinal dimension is in the machine direction, it is also possible that it is in the transverse dimension. The Lazar patent thus cannot properly be said to disclose each and every limitation in independent claims 80 and 84, and the rejected claims depending therefrom. *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981) (inherency may not be established by probabilities or possibilities).

We will not sustain the rejection of claims 80, 81, 84, 86 and 90 under 35 U.S.C. § 102(b) as anticipated by Lazar.

Claims 84, 85, and 88--Anticipation by Chan

The Examiner has rejected claims 84, 85 and 88 as being anticipated by Chan. As was the case in the anticipation rejection in view of Lazar, the Examiner has made no findings that the Chan patent explicitly or inherently discloses a method including providing a paper web that has its longitudinal dimension in the machine direction and its transverse dimension in the cross-machine direction. The Examiner’s position with respect to these limitations is effectively the same as in the rejection based on anticipation by Lazar, discussed above. (Answer 7-8).

That position, which effectively ignores the claimed relationship of the machine and cross-machine directions to the longitudinal and transverse

dimensions of the paper web, is in error. Chan does not explicitly or inherently disclose that this relationship exists in the paper products being folded therein, as acknowledged by the Examiner. The Chan patent thus cannot properly be said to disclose each and every limitation in independent claim 84, and the rejected claims depending therefrom.

We will not sustain the rejection of claims 84, 85 and 88 under 35 U.S.C. § 102(b) as anticipated by Chan.

Claims 82, 83, and 87--Obviousness--Lazar in view of “Applicant’s Admitted Prior Art” (AAPA)

Claims 82 and 83 depend from independent claim 80, and claim 87 depends from independent claim 84. These dependent claims set forth certain materials properties or characteristics of the paper web being formed into a paper napkin.

The Examiner contends that it would have been obvious to perform the folding method of Lazar on various sizes and weights of webs, as the method does not appear to be affected by the sizes or weights, and employing paper webs of such sizes or weights solves no stated problem. (Answer 4-5). The Examiner notes that this alleged “common knowledge modification is taken to be admitted prior art because applicant failed to traverse the examiner’s assertion of official notice.” (*Id.* at 5).

The assertion of “official notice” referred to in the Examiner’s Answer appeared in a Non-Final Office Action dated June 23, 2005 (“Office Action”). There, the Examiner stated:

Lazar does not directly disclose the ranges of dimensions, nor the weight per sq ft of the product. However the examiner takes OFFICIAL NOTICE that it would have been obvious to one of ordinary

skill in the art to apply the folding method of Lazar to various sizes and weights of webs including those of claims 82 and 87.

Office Action 4.

While Appellants have not specifically challenged the Examiner's assertion of official notice, which would ordinarily elevate facts stated in the assertion to the level of admitted prior art, here, the assertion of official notice is not directed to establishing evidentiary facts, but is rather an attempt to establish the ultimate legal conclusion of obviousness as to the rejected claims. The procedures setting forth the circumstances in which official notice may properly be taken do not recognize any basis for the taking of official notice of a legal conclusion (MPEP § 2144.03), nor do we believe that this would be proper under any circumstances.

More significantly, as pointed out by Appellants (Reply Br. 14), the rejection under 35 U.S.C. § 103(a) in view of Lazar and the alleged admitted prior art does not remedy the deficiencies of the teachings of Lazar as discussed above in connection with the § 102 rejection over Lazar. The Examiner has taken the erroneous position that the limitations in the claims directed to the machine direction and cross-machine direction of the paper web may not serve in any way to distinguish the claims over the prior art.

Claims 82, 83, and 87 require, by virtue of their dependence on claims 80 and 84, that the longitudinal dimension of the web be in the machine direction, and that the transverse dimension be in the cross-machine direction. The grounds for rejecting these claims as being obvious do not assert that these limitations are identically disclosed in, or allege that they would have been obvious in view of, the Lazar patent.

We will not sustain the rejection of claims 82, 83, and 87 under 35 U.S.C. § 103(a).

Claims 84, 85, 88 and 89--Obviousness--Ito

The Examiner characterizes the Ito patent as describing transverse folds in a web, using multiple fold configurations, to produce wipes. (Answer 5). The Examiner acknowledges that Ito does not disclose a method employing a single-ply paper web, but asserts that it would have been obvious to use the Ito method for a single-ply if desired. In support of this assertion, the Examiner states that: (a) Appellants have not disclosed that a single-ply paper web provides an advantage, is used for a particular purpose, or solves a stated problem; (b) one of skill in the art would have expected Appellants' invention to perform equally well with any web of foldable material because the method steps do not rely on the material being folded; and (c) it is within the general skill of a worker in the art, and is an obvious design choice, to select a known material on the basis of its suitability for the intended use. (*Id.*).

Appellants principally contend that one of ordinary skill in the art would not have been motivated to modify a process for producing a four-ply industrial wiper product to produce single-ply articles, as the resulting product would be sufficiently weaker such that it would be rendered unsuitable for its intended use. (Appeal Br. 43). Appellants further assert that Ito does not disclose or suggest the use of a paper web that has a longitudinal dimension that is at least about two times the transverse dimension. (Appeal Br. 45).

As to this latter contention, the Examiner has not affirmatively stated

in the Answer that the Ito reference discloses or renders obvious the use of a paper web that has a longitudinal dimension that is at least about two times the transverse dimension. It is not clear from the grounds of rejection (Answer 5) or from the Response to Argument (Answer 10) whether the Examiner has regarded the Ito paper web as being the entire web 12 (Ito, Fig. 1) being processed, or as being each one of the separable wiper sheets 12A (Ito, Fig. 2). If the former, it appears likely that the longitudinal dimension is considerably greater than two times the transverse dimension.⁵ If the latter, Ito provides no specific guidance as to what the relationship of these dimensions should be, although we note that, in Figure 2 of Ito, the wiper sheet 12A has a longitudinal-to-transverse dimensional ratio of about 1.6:1. The grounds of rejection are further devoid of any contentions or reasoning as to why this claim limitation would have been obvious in view of Ito.

Moreover, the rationale set forth by the Examiner as to why it would have been obvious to modify the Ito process to employ a single-ply web has been shown by Appellants to be flawed. The Examiner took the position that the disclosure of the use of a four-ply web was not “exclusive”, citing to evidence in Ito that webs having less than four plies might be employed. (Answer 10). Appellants point out that the portion of the disclosure of Ito in which it is disclosed that the web might have less than four plies (Ito, col. 7, ll. 44-52) refers to using alternate, non-paper materials, rather than the four-

⁵ It does not appear that this was what the Examiner intended, but if so, this calls into question whether the Ito patent would disclose or render obvious a method in which a transverse free edge is folded toward the other transverse edge, and the fold line thus created is then folded toward that same transverse free edge, as claimed.

ply creped wadding material disclosed in the first-disclosed preferred embodiment. Specifically, that passage in Ito refers to the possibility that a nylon scrim reinforced tissue laminate or a polyolefin material could be employed. (FF 3). As such, a person of ordinary skill in the art would be led to consider using less than four plies only if the material is changed to something that is presumably stronger than the creped wadding material of the first preferred embodiment. This strongly suggests that a single-ply paper web, as claimed by Appellants, would not be suitable for the intended purpose of the wipers produced by Ito, and that it is erroneous to conclude that modifying the Ito process to employ a single-ply paper web would have been obvious.

We will not sustain the rejection of claims 84, 85, 88 and 89 as being obvious over the Ito patent.

CONCLUSION

Appellants have established that reversible error exists in the rejections of claims 80-90 under 35 U.S.C. § 112, second paragraph; of claims 80, 81, 84-86, 88 and 90 under 35 U.S.C. § 102(b); and of claims 82-85 and 87-89 under 35 U.S.C. § 103(a).

ORDER

The decision of the Examiner to reject claims 80-90 is reversed.

REVERSED

Appeal 2009-001146
Application 10/689,379

mls

GEORGIA PACIFIC, LLC
133 PEACHTREE STREET NE – GA030-41
ATLANTA, GA 30303